



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,739	05/26/2004	Itzhak Bentwich	050992.0302.00USCP	3738
37808	7590	05/23/2008		
ROSETTA-GENOMICS c/o PSWS 700 W. 47TH STREET SUITE 1000 KANSAS CITY, MO 64112			EXAMINER SCHNIZER, RICHARD A	
			ART UNIT 1635	PAPER NUMBER
			MAIL DATE 05/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/709,739

Applicant(s)

BENTWICH ET AL.

Examiner

Richard Schnizer, Ph. D.

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26, 31, 33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 31, 33 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2004 and 02 January 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

An amendment was received and entered 4/10/08.

Claims 38-40 were canceled.

Claims 26, 31, 33, and 35-37 are pending and under consideration.

Rejections not reiterated are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 26, 31, and 33 stand rejected under 35 U.S.C. 102(e) as being anticipated by Pfeffer et al (US 20050222067).

Pfeffer taught SEQ ID NO: 82 which is identical to instant SEQ ID NO: 4204050. See Table A2 at page 5 of Pfeffer. Pfeffer also taught vectors comprising SEQ ID NO: 82. See paragraphs 31-33 and claims 70 and 72. Note that SEQ ID NO: 82 is considered to be a probe comprising the sequence of instant SEQ ID NO: 4204050, as are the vectors of '067 claims 70 and 72.

Response to Arguments

Applicant's arguments filed 4/10/08 have been fully considered but they are not persuasive.

At page 3 of the remarks Applicant asserts that Pfeffer is not available as prior art because the instant application claims priority to PCT/IL03/09998 filed 11/23/03 which antedates Pfeffer. Applicant asserts that instant SEQ ID NO: 4204050 is disclosed in the PCT application as SEQ ID NO: 1073. A copy of the PCT application has not been filed in this application, so no evidence has been provided to support this assertion. After a reasonable effort, the Office has not yet been able to procure a copy of the PCT. A search of the prior art did not reveal the sequence in any WO documents. In the absence of evidence that the claimed sequence is disclosed in the PCT the Office cannot withdraw the rejection..

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pfeffer et al (US 20050222067).

Pfeffer taught SEQ ID NO: 82 which is identical to instant SEQ ID NO: 4204050. See Table A2 at page 5 of Pfeffer.

Pfeffer did not explicitly teach a sequence consisting of instant SEQ ID NOS: 117937 or 118171. However, Pfeffer did explicitly disclose instant SEQ ID NO: 4204050, which comprises instant SEQ ID NOS: 117937 or 118171, and Pfeffer also fairly taught isolated molecules comprising 10-50 bases of SEQ ID NO: 82, and vectors comprising these sequences. See paragraphs 17, 18, and 31-33.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make any 10-50 base fragment of SEQ ID NO: 82 of Pfeffer for use as an inhibitory RNA molecule because Pfeffer makes this suggestion at paragraphs 17 and 18. Further Pfeffer discloses a 22-base fragment that differs from instant SEQ ID NO: 117937 by beginning and ending 1 base earlier in the sequence of SEQ ID NO: 82 than does instant SEQ ID NO: 117937 (see the first sequence disclosed in Table A2, i.e. SEQ ID NO: 71) , so it is clear that one of ordinary skill would have considered 22 base fragments of SEQ ID NO: 82 as inhibitory RNA molecules. In so doing one would have arrived at all forty-six possible 22 base fragments of SEQ ID NO 82. Thus the invention as a whole was prima facie obvious.

Response to Arguments

Applicant's arguments filed 4/10/08 have been fully considered but they are not persuasive.

At page 4 of the remarks Applicant reiterates the assertion that Pfeffer is not available as prior art because the instant application claims priority to PCT/IL03/09998 filed 11/23/03 which antedates Pfeffer. Applicant asserts that instant SEQ ID NO:

4204050 is disclosed in the PCT application as SEQ ID NO: 1073. A copy of the PCT application has not been filed in this application, so no evidence has been provided to support this assertion. After a reasonable effort, the Office has not yet been able to procure a copy of the PCT. A search of the prior art did not reveal the sequence in any WO documents. In the absence of evidence that the claimed sequence is disclosed in the PCT the Office cannot withdraw the rejection. Further, it is noted that the disclosure of a nucleic acid consisting of the sequence of SEQ ID NO: 4204050 is not necessarily a disclosure of a sequence consisting of SEQ ID NO: 117937. For these reasons the rejection is maintained.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 571-272-0762. The examiner can normally be reached Monday through Friday between the hours of 6:00 AM and 3:30 PM. The examiner is off on alternate Fridays, but is sometimes in the office anyway.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, James (Doug) Schultz, can be reached at (571) 272-0763. The official central fax number is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Richard Schnizer, Ph. D./
Primary Examiner, Art Unit 1635